

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Drawing objection

Reconsideration and removal of the drawing objection is respectfully requested, in view of the cancellation of the recitation in claim 1 of the second pressing member arranged to be driven, on the basis that the indicated feature has been removed from the claims.

Although support can be found for the feature of the second pressing member arranged to be driven in Figs. 1-9 as originally filed, and, for example, at least on page 18, line 14 through page 19, line 10, in the interest of advancing prosecution, the recited feature has been removed from the claims.

Accordingly, removal of the drawing objection is respectfully requested.

2. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

A. Claim amendments

Claim 1 is amended to remove the recitation of the second pressing member being arranged to be driven and to provide clear antecedent basis for every recited feature. It is respectfully submitted that no new matter is added, since the changes merely remove a feature and correct a minor informality.

Claim 2 is amended to remove the recitation of the second pressing member and to provide clarity. It is respectfully submitted that no new matter is added, since the changes merely remove a feature and provide clarity.

Claim 3 is amended to remove the recitation of the first pressing member. It is respectfully submitted that no new matter is added, since the change merely removes a feature.

Claims 4-6 and 12-16 remain canceled.

Claims 7-11 and 17-19 are left unchanged.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

B. Rejection of claims 1-3, 7-11, and 17-19 under 35 U.S.C. § 112 first paragraph

Reconsideration of this rejection is respectfully requested, in view of the cancellation of the recitation in claim 1 of the second pressing member arranged to be driven, on the basis that the indicated feature has been removed from the claims.

Although support can be found for the feature of the second pressing member arranged to be driven in Figs. 1-9 as originally filed, and, for example, at least on page 18, line 14 through page 19, line 10, in the interest of advancing prosecution, the recited feature has been removed from the claims.

Accordingly, withdrawal of this rejection is respectfully requested.

C. Rejection of claims 1-3, 7-11, and 17-19 under 35 U.S.C. § 112 second paragraph

Reconsideration of this rejection is respectfully requested, in view of the amendments to claims 1 and 2 to correct minor informalities and the cancellation of the recitation in claim 1 of the second pressing member arranged to be driven, on the basis that the noted informalities have been corrected and the indicated feature has been removed from the claims.

As discussed, the alternative recitation of a second pressing member arranged to be driven has been removed from claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

As also discussed above, claim 1 is amended to replace the phrase “a base end” with the phrase “the first block” in order to provide clear antecedent basis for every feature of claim 1. The first block is recited in the second line of claim 1, and therefore finds clear antecedent basis in claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

As further discussed above, claim 2 is amended to provide clarity by removing the word “canceling” and using instead the clear term “releasing.” Accordingly, withdrawal of this rejection is respectfully requested.

The remaining claims depend from claim 1, and are clear and definite.

In view of the above discussion, withdrawal of the rejection of claims 1-3, 7-11, and 17-19 as being indefinite is respectfully requested.

3. Rejection of claims 1-3, 7, 9, 11, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 20030160374 (*Yonezawa*) in view of U.S. patent no. 5,427,349 (*Obrecht*)

Reconsideration of this rejection is respectfully requested on the basis that the proposed combination of the *Yonezawa* publication and the *Obrecht* patent fails to disclose each and every recited element of claim 1, and thus fails to establish a *prima facie* case of obviousness with respect to claim 1. The remaining claims depend from claim 1, and are therefore patentable as containing all of the recited elements of claim 1, as well as for their respective recited features.

By way of review, the embodiment of claim 1 requires a positioning apparatus that includes a plug member projecting from a first block and adapted for insertion into a positioning hole in a second block. A plurality of slide portions are arranged around the plug member and are opposed to each other across the plug member in an opposed direction. The slide portions are arranged for movement in a first radial direction that is substantially orthogonal to the opposed direction. A first pressing member is arranged outside the slide portions in a diametrically expandable and contractible, and an axially movable manner. A second pressing member is arranged

outside the slide portions and inside the first pressing member in a diametrically expandable and contractible, and an axially movable manner. The first pressing member is arranged to be driven toward the first block by a drive arrangement such that the slide portions expand the first pressing member in a second radial direction, different from the first radial direction.

In contrast to the embodiment of claim 1, the *Yonezawa* publication fails to disclose at least a second pressing member that is diametrically expandable and contractible or a plurality of slide portions opposed to each other across a plug member in an opposed direction and arranged around the plug member.

Instead, the *Yonezawa* publication discloses a plug member 12 having three slant outer surfaces 13 (paragraph [0046]). An annular intermediate member 15 is arranged around the plug member 12 (paragraph [0047]). The intermediate member 15 has an inner periphery that includes three slant inner surfaces 17 opposed to the slant outer surfaces 13 of the plug member 12 (paragraph [0049]). Three metal balls 18, or rolling members, or cylindrical or spherical rolling members, are inserted between the respective slant outer surfaces 13 and the slant inner surfaces 17 (paragraph [0050]). In use, the slant inner surfaces 17 make a wedging engagement with the slant outer surfaces 13 through the balls 18 (paragraph [0057]).

While there is a possibility that the balls 18 may move radially outwardly and axially along the slant inner surfaces 17, the balls 18 do not diametrically expand and contract, as is required of the second pressing member recited in claim 1.

Further, there is simply no disclosure in the *Yonezawa* publication of a plurality of slide portions opposed to each other across a plug member in an opposed direction and arranged around the plug member, as is required by claim 1.

The Office action turns to the *Obrecht* patent to cure these deficiencies of the *Yonezawa* publication, however, as will be discussed below, the *Obrecht* patent fails to provide for the shortcomings of the *Yonezawa* publication.

The *Obrecht* patent describes an adjustable base assembly that is provided to adjust the horizontal and vertical position of a fabrication tool by use of a movable carriage assembly that can move horizontally and includes wedging structures to vertically adjust a surface (abstract; col. 1, lines 30-66).

Specifically, the *Obrecht* patent describes a lower wedge plate assembly 12 with a lower wedge plate 30, an upper wedge plate assembly 18 with an upper wedge plate 60, and a pair of wedge blocks 20, 21. The lower wedge plate 30 includes an upper surface 30a defining a pair of upwardly converging wedge faces 30b that converge at an apex 30c (col. 3, lines 25-27). The upper wedge plate 60 includes a lower surface 60a defining a pair of downwardly converging wedge faces 60b converging at an apex 60c (col. 4, lines 25-27). Each wedge block 20, 21 includes converging upper and lower wedge faces 20d, 21d, and 20e, 21e that are inclined from the horizontal at an angle equal to the angle of inclination of the wedge faces 30b and 60b of the lower and upper wedge plates (col. 4, lines 38-45). Each wedge block includes a threaded bore and receives a vertical adjustment screw 70 therein.

The wedge blocks are sandwiched between the upper and lower wedge plates with their lower wedge faces 20e, 21e in sliding engagement with a respective wedge face 30b of the lower wedge plate and the upper wedge faces 20d, 21d in sliding engagement with the wedge faces 60b of the upper wedge plate (col. 5, lines 22-29).

By adjusting the screw 70, the wedge blocks can be slid axially closer together or spaced further apart, such that the upper and lower wedge plates can be pushed apart or brought closer together (col. 5, lines 48-61).

There is no disclosure, however, that the wedge blocks 20, 21 are diametrically expandable and contractible, as is required of the second pressing member recited in claim 1.

Additionally, if the *sliding* wedge blocks 20, 21 of the *Obrecht* patent were used in place of the *rolling* balls 18 of the *Yonezawa* publication, the positioning device of the *Yonezawa* publication would cease to function. Specifically, since the inner and outer slant surfaces of the *Yonezawa* publication have the same slanting

orientation, the wedge shaped blocks of the *Obrecht* patent would not allow relative movement or clamping engagement between the inner and outer slant surfaces. Accordingly, there is no reason that a skilled artisan would have replaced the balls 18 of the *Yonezawa* publication with the wedge blocks 20, 21 of the *Obrecht* patent, since such a replacement would destroy the function of the positioning device of the *Yonezawa* publication. According to MPEP §2143.01 (V), the proposed combination cannot render the prior art unsatisfactory for its intended purpose.

Further, the *Yonezawa* publication specifically describes *rolling* members positioned between the inner and outer slant surfaces, and there is no reason that a skilled artisan would have replaced the *rolling* members of the *Yonezawa* publication with the *sliding* members of the *Obrecht* patent, since again, such a change would destroy the function of the positioning device of the *Yonezawa* publication.

Additionally, the *Obrecht* patent fails to disclose a plurality of slide portions opposed to each other across a plug member in an opposed direction and arranged around the plug member, as required by claim 1.

Even if the lower wedge plate 30 of the *Obrecht* patent were to be considered as a slide member (as asserted in the Office action on page 4), there is no reason why a skilled artisan would add the lower wedge plate 30, and all of the associated structure required to move the wedge plate horizontally (see for example bearing assemblies 42, 44 and horizontal adjustment screw assembly 16), to the positioning device of the *Yonezawa* publication. In particular, there is simply no space between the balls 18 and the plug member of the *Yonezawa* publication in which to place all of the necessary structure to allow the wedge plate of the *Obrecht* patent to move horizontally.

Further, there is particularly no reason to provide a plurality of lower wedge plates, and all of the associated structure required to move the wedge plate horizontally, to the positioning device of the *Yonezawa* publication since there is simply no space for even a single wedge plate and associated structure between the balls 18 and the plug member of the *Yonezawa* publication. And, absent the improper

hindsight use of the applicants' own disclosure, there is no reason to provide any slide members to the positioning device of the *Yonezawa* publication.

Thus, since the *Yonezawa* publication and the *Obrecht* patent each fail to disclose a second pressing member that is diametrically expandable and contractible or a plurality of slide portions opposed to each other across a plug member in an opposed direction and arranged around the plug member, the proposed combination of the *Yonezawa* publication and the *Obrecht* patent fails to disclose these features.

Further, a skilled artisan would not have had any reason to combine the wedge assembly of the *Obrecht* patent with the positioning device of the *Yonezawa* publication for the reasons discussed above.

Accordingly, since the proposed combination of the *Yonezawa* publication and the *Obrecht* patent fails to disclose every feature of claim 1, and since a skilled artisan would not have had any reason to combine the wedge assembly of the *Obrecht* patent with the positioning device of the *Yonezawa* publication, a *prima facie* case of obviousness cannot be maintained with respect to claim 1, and withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claim 1 is patentable and therefore, claims 2, 3, 7, 9, 11, and 17-19, which depend from claim 1, are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective recited features.

4. Rejection of claims 8 and 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 20030160374 (*Yonezawa*) in view of U.S. patent no. 5,427,349 (*Obrecht*) and further in view of U.S. patent no. 6,604,738 (*Haruna*)

Reconsideration of this rejection is respectfully requested on the basis that the *Haruna* patent fails to provide for the deficiencies of the *Yonezawa* publication and the *Obrecht* patent, as discussed above with respect to amended claim 1, from which claims 8 and 10 depend.

Since claims 8 and 10 depend from claim 1 they are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective recited features.

Accordingly, withdrawal of this rejection is respectfully requested.

5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,



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